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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,929	12/21/2001	Yoshiki Habu	S-31005 A	8276

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SYNGENTA BIOTECHNOLOGY, INC.

PATENT DEPARTMENT

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EXAMINER

ROBINSON, HOPE A

ART UNIT

PAPER NUMBER

1656

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/018,929

Applicant(s)

HABU ET AL.

Examiner

Hope A. Robinson

Art Unit

1656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6-8,10,17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) 10,17 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 6-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/20/02
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 1656.

2. Applicant's response to the Office Action mailed February 9, 2005 on July 9, 2005, is acknowledged.

3. Claims 2-5, 9 and 11-16 have been canceled. Claims 1 and 8 have been amended. Claims 1, 6-8, 10 and 17-18 are pending. Claims 1 and 6-8 are under examination.

4. This application contains claims 10 and 17-18 drawn to an invention nonelected without traverse November 3, 2003. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Restriction Requirement

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6. On page 5 of the amendment, applicant state that they disagree with the classification of claim 17 and 18 and argue that it should be in Group I. Applicants are reminded that on November 3, 2003 an election was made to prosecute Group I claims 1-18 without traverse. Furthermore, the communication mailed on February 9, 2005 set forth the differences between claims 17-18 and the elected group (previously examined on the merits). Applicant is entitled to one invention per application. Thus, this argument is not persuasive and claims 17-18 will not be rejoined.

Withdrawn - Objections to the Specification

7. Previous objection to the specification for missing an abstract is withdrawn by virtue of submission of a new abstract.

Previous objection to the specification for inappropriate notation of an internet address is withdrawn based on Applicant's amendment.

Withdrawn - Claim Objections

8. Previous objection to claims 1, 2, 8 and 11-16 have been withdrawn based on applicant's amendments to the claims, wherein some claims have been cancelled or recite language that corrects the deficiencies.

Withdrawn - Claim Rejections - 35 U.S.C. § 112, second paragraph

9. Previous rejection of claims 3, 9 and 12 under 35 U.S.C. § 112, second paragraph, as being indefinite is withdrawn by virtue of the amendments which cancelled the claims.

Withdrawn - Claim Rejections - 35 U.S.C. § 112, first paragraph

10. Previous rejection of claims 1-4 and 7 under 35 U.S.C. § 112, first paragraph enablement/written description is withdrawn based on applicant's amendments to the claims.

11. The following grounds of objection/rejection are or remain applicable:

New Objections to the Specification

12. The specification is objected to because of the following informalities:

(a) The specification is objected to because the priority information is not listed on page 1, for example, "This application is a 371 of PCT/EP00/05761 filed 6/21/00 which claims benefit of UK 9914623.5 filed June 23, 1999.

(b) In addition, the abstract submitted on July 9, 2005 is objected to for the following, "...in particularDNA encoding the MOM..."

Correction is required.

New Claim Objections

13. Claims 1, 6 and 8 are objected to because of the following informalities:

Claims 1 and 8 are objected to because the following appears, "SEQ ID NO.3" instead of "SEQ ID NO:3".

Claim 6 is objected to for the recitation of , "claim1" instead of "claim 1".

Correction of the above is required.

Claim Rejections - 35 USC § 101-Maintained

14. Claims 1 and 6-8 remain rejected under 35 U.S.C. 101, as lacking utility, for the reasons of record.

Response to Applicant's Arguments:

Applicant's arguments filed on July 9, 2005 have been considered. However, are not persuasive. Applicant state on page 7 of the amendment that page 5 of the specification describes the amino acid sequence motifs of the MOM protein identified in the application and the alignment additionally reveals a region similar to part of the ATPase/helicase domain of proteins in the SEQ12/SNF2 family which are involved in chromatin remodeling but no significant overall sequence identity with known proteins. It is further stated that if you have a transgenic plant where the transgene has been silenced through a transcriptional silencing mechanism, such silencing can be released by interfering with the expression of the MOM protein.

Applicant's comments are noted, however, is presented in a 'real world context' and this utility is not specific. MPEP 2107.01 states that, "Utilities that require or constitute carrying out further research to identify or reasonably confirm 'real world' context of use are not substantial utilities". In view of the foregoing, and absent data/evidence, the claimed invention lack utility. See *Brenner v. Manson*, 383, U.S.

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519, 535-36, 148 USPQ 689, 696 (1966), noting that "a patent is not a hunting license. It is a reward for the search, but compensation for its successful conclusion". A patent is therefore not a license to experiment. See also the Utility Guidelines available at www.uspto.gov.

Furthermore, the arguments presented by applicant on pages 7+ of the amendment filed appears to suggest that similarity between the claimed protein and others in the art endows function to the claimed protein. This argument is not persuasive as the art generally recognizes that sequence identity to a known protein with function does not automatically mean that the newly discovered protein will exhibit the same function or have biological activity. Furthermore, the issue raised in the rejection is that the claimed invention is directed to gene silencing proteins, the DNA that encodes the same and methods of making said DNA, however, the instant specification describes the function of the identified protein in vague terms. No description of the locus and why one might want to silence the locus is found in the specification. Further, there is no indicia of how broadly SEQ ID NO:3, or related sequences, can be used, for example, can the claimed protein be used to silence other loci of *A. thaliana* that contain genes whose silencing is considered to be useful? Thus the claimed invention has not been presented in mature form as the usefulness of even exactly SEQ ID NO:3 (encoding SEQ ID NOS: 1 and 2) is unclear. For these reasons and the reasons of record the rejection remains.

Conclusion

15 No claims are allowable.

16. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hope A. Robinson whose telephone number is 571-272-0957. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Kerr, can be reached at (571) 272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hope Robinson, MS *HR*

Patent Examiner *7/18/05*



KATHLEEN M. KERR, PH.D.
SUPERVISORY PATENT EXAMINER